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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85034559
Applicant	Somerset Soup Works, Inc.
Applied for Mark	SOUP SINGLES
Correspondence Address	TIMOTHY D PECSENYE BLANK ROME LLP ONE LOGAN SQUARE, 8TH FLOOR PHILADELPHIA, PA 19103-6998 UNITED STATES pecsenye@blankrome.com
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Attachments	12221643_1.pdf (26 pages)(55585 bytes)
Filer's Name	Matthew A. Homyk
Filer's e-mail	mhomyk@blankrome.com
Signature	/Matthew A. Homyk/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

APPLICANT: Somerset Soup Works, Inc.
SERIAL NO.: 85/034,559
TRADEMARK: SOUP SINGLES
FILING DATE: May 10, 2010
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To: Hon. Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

BRIEF OF APPLICANT IN SUPPORT OF REGISTRATION

BLANK ROME LLP
One Logan Square
Philadelphia, PA 19103
(215) 569-5745

Attorneys for Applicant,
Somerset Soup Works, Inc.

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STATEMENT OF ISSUES FOR REVIEW

1. Is Applicant's mark merely descriptive under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1)?
2. Did the Examining Attorney err in requiring a disclaimer of the term "SOUP"?
3. In the alternative, is the evidence insufficient to establish acquired distinctiveness of the SOUP SINGLES mark?

STATEMENT OF THE CASE

This action arises from the final refusal to register Applicant Somerset Soup Works, Inc.'s (hereinafter, "Applicant") trademark SOUP SINGLES. The denial by the Examining Attorney is based on § 2(e)(1) of the Lanham Act, alleging that the mark is merely descriptive of Applicant's identified goods, and therefore not entitled to registration (without a showing of secondary meaning). Moreover, the Examining Attorney stated that Applicant's evidence is insufficient to establish acquired distinctiveness of the mark. Additionally, the Examining Attorney made final her requirement that Applicant disclaim the term "SOUP." Applicant objects to the Examining Attorney's final conclusion and responds that the mark is a unitary, suggestive mark and therefore is entitled to registration without disclaimer.

PROCEEDINGS AND DISPOSITION BELOW

Applicant applied for registration of its mark, SOUP SINGLES, on May 10, 2010. The Examining Attorney initially refused registration by Office Action dated August 28, 2010, based on the preliminary finding that the mark was merely descriptive of Applicant's goods and that a disclaimer of the term "SOUP" was required. A response to the outstanding Office Action was filed on February 28, 2011. The Examining Attorney again denied registration, making the refusal final by Office Action dated March 22, 2011. Applicant filed an Amendment to Allege Use on September 21, 2011. Applicant then filed a Request for Reconsideration amending its application to seek registration pursuant to Section 2(f) on September 22, 2011, accompanied by a notice of Ex Parte Appeal From Examiner of Trademarks. On September 23, 2011, the Trademark Trial and Appeal Board (hereinafter "T.T.A.B.") mailed notification to Applicant that its request for reconsideration was acknowledged, and the case was remanded to the Examining Attorney for review. Subsequently, the Examining Attorney again denied registration by Office Action dated October 18, 2011, continuing the descriptiveness refusal and disclaimer requirement and rejecting Applicant's evidence of acquired distinctiveness. Applicant timely filed a Request for Reconsideration on April 18, 2012, accompanied by further evidence of acquired distinctiveness. On

May 8, 2012, the Examining Attorney mailed her response to Applicant's Request for Reconsideration, maintaining her final disclaimer requirement. On May 25, 2012, the T.T.A.B. notified Applicant that its appeal was resumed with sixty days in which to file its brief herein.

STATEMENT OF FACTS

Applicant coined the phrase SOUP SINGLES to be employed as a trademark for "frozen soups." The mark was selected, in part, for its unique cadence and alliteration, as well as for its suggestive qualities as a trademark connoting an easy packaged dinner, lunch, or snack.

Applicant filed to register its mark with the United States Patent and Trademark Office ("PTO") on May 10, 2010. However, in a series of Office Actions, the Examining Attorney finally refused registration of Applicant's trademark on the ground that the mark is allegedly merely descriptive of Applicant's identified goods pursuant to § 2(e)(1) of the Lanham Act, and that the term "SOUP" must be disclaimed. In the course of prosecution, the Examining Attorney provided screenshots of products available for purchase on the Internet and Internet dictionary evidence allegedly in support of the argument that the individual words that compose Applicant's mark, as well as Applicant's composite mark as a whole, are merely descriptive. Applicant responded to the denials of registration by arguing that its mark is not merely descriptive when considered in connection with the associated goods, also providing evidence of third party registrations in support of Applicant's position. This appeal is the culmination of that prosecution history.

The Examining Attorney later rejected Applicant's argument that Applicant's mark has acquired distinctiveness under Section 2(f) of the Lanham Act despite evidence provided by Applicant of a large marketing effort, including participation in trade shows, distribution of circulars, public-relations pieces in newspapers and magazines, and blogs, and widespread sales of its frozen soups under the SOUP SINGLES mark, including gross revenues from its SOUP SINGLES frozen soups of \$315,466.50 over the last six months of 2011.

SUMMARY OF ARGUMENT

A mark is not merely descriptive if, when taken in context, imagination or thought or perception is required to reach a clear conclusion as to the nature of the goods. Applicant's mark requires consumers to make mental leaps before they can reach a conclusion as to the true nature of the Applicant's goods. Specifically, the mark SOUP SINGLES suggests the portion size, but also cleverly suggests the consumers who would find the product convenient -- individuals living alone. Applicant's creative mark is suggestive since SOUP SINGLES does not immediately convey any one message.

Additionally, the mark's alliteration of the first letter, "S," of both component terms in the mark, and a sharp cadence formed between the words "SOUP" and "SINGLES" that results from the emphasis on both words being placed on the beginning of the

word, give the average consumer the commercial impression of a unique source identifier, not a merely descriptive phrase.

Moreover, the SOUP SINGLES mark is a unitary mark that should not be dissected into its components for purposes of disclaimer. The catchy alliteration and cadence of the mark result in a unitary mark that must not be dissected.

Additionally, Applicant has presented substantial evidence of widespread marketing and sales over several years that establish the acquired distinctiveness of Applicant's mark.

Further, the Examining Attorney failed to resolve all doubts concerning registration in Applicant's favor. Where Applicant's mark is at worst on the cusp between suggestive and merely descriptive marks, a proper balancing of the doubts at hand favors publication of Applicant's mark for opposition.

As a result of the foregoing, Applicant's mark is -- on the continuum of trademarks -- suggestive and thus inherently registrable.

ARGUMENT

I. DESCRIPTIVENESS STANDARD

Marks fall into one of five classifications including: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976). "Although these categories are meant to be mutually exclusive, they are spectrum-like and tend

to merge imperceptibly from one to another." Vision Center v. Opticks, Inc., 596 F.2d 111, 115 (5th Cir. 1979), cert. denied, 444 U.S. 1016 (1980); see also In re Morton-Norwich Prods., Inc., 209 U.S.P.Q. 791 (T.T.A.B. 1981) ("finding thin line between a suggestive and a merely descriptive designation"). Because of the sometimes subtle differences between classifications they are "frequently difficult to define and quite frequently difficult to apply." Vision Center, 596 F.2d at 115.

In addressing the subject of descriptive wording, the Federal Circuit in the case, In re Gyulay, 820 F.2d 1216 (Fed. Cir. 1987), recognized the language of the Trademark Trial and Appeal Board establishing that descriptiveness refusals are relevant when "the mark merely describes a significant characteristic of the goods." Id., 820 F.2d at 1217.

The language of the Federal Circuit continued: "Whether a given mark is suggestive or merely descriptive depends on whether the mark 'immediately conveys . . . knowledge of the ingredients, qualities, or characteristics of the goods . . . with which it is used', or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods.'" In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 525, 205 U.S.P.Q. (BNA) 505, 507 (C.C.P.A. 1980). The categories are in actuality 'central tones in a spectrum . . .

and are frequently difficult to apply.'" Id. at 1217 (citation omitted, emphasis added). It is clear, therefore, that a mark or portion thereof must immediately convey knowledge to support a request to disclaim that portion. The commercial impression cannot be a time-consuming, tenuous, or pensive connection -- it must be immediate. If a certain image of Applicant's goods does not immediately come to mind upon hearing or seeing the mark then *some imagination* must be required to connect the mark to the goods. See Self-Realization Fellowship Church v. Ananda, 59 F.3d 902, 911 (9th Cir. 1995) ("If the mental leap between the word and product's attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness."); and In re Application of ABCOR Development Corp., 588 F.2d 811, 814 (C.C.P.A. 1978) ("Generally speaking, if the mark imparts information directly, it is descriptive. If it stands for an idea which requires some operation of the imagination to connect it with the goods, it is suggestive." (citation omitted)).

As clarified in the T.M.E.P., however, "a designation does not have to be devoid of all meaning in relation to the goods and services to be registrable." T.M.E.P. § 1209.01(a) (4th ed. 2005) (emphasis added); see also HQ Network Sys. v. Executive Headquarters, 755 F. Supp. 1110 (D. Mass. 1991) (finding mark "'HEADQUARTERS COMPANIES' is on the cusp between being

descriptive and being suggestive. It is, if you will, a suggestive mark with descriptive elements"). Understanding that a suggestive mark may carry a certain meaning or significance and yet be fully registrable (i.e., without disclaimer or distinctiveness limitation), is crucial to the case at hand.¹

Moreover, it is a general and well-established principle that "a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning" T.M.E.P. § 1209.03(d) (4th ed. 2005). In the case, In re Colonial Stores Inc., 394 F.2d 549, 157 U.S.P.Q. 382 (C.C.P.A. 1968), the court explained:

[w]hile it may be true that each of the individual words in the present applicant's mark are generic and thus independently unregistrable, it seems to me that their unusual association or arrangement in the applicant's mark results in a unique and catchy expression which does not, without some analysis and rearrangement of its components suggest the contents of applicant's goods.

394 F.2d at 552 (citing Ex Parte Baker, 92 U.S.P.Q. 218 (Comm'r Pat. & TM 1952)).

The Ninth Circuit in California Cooler, Inc. v. Loretto Winery, Ltd., 774 F.2d 1451 (9th Cir. 1985), recognized that "words which could not individually become a trademark may

¹An alternate phrasing of the "imagination" test asks whether others in the same business would generally need the word to adequately describe their product or service. However, "[t]he need to use a term because it is generic or highly descriptive should be distinguished from the desire to use it because it is attractive." Union Nat'l Bank of Texas, Laredo v. Union Nat'l Bank of Texas, Austin, 909 F.2d 839, 848 (5th Cir. 1990).

become one when taken together. . . . It is the likely reaction of customers to the total mark that is at issue. . . . Thus, the composite may become a distinguishing mark even though its components individually cannot." Id. at 1455. Likewise, the Trademark Trial Appeal Board in In re Waldorf Paper Products, 155 U.S.P.Q. 174 (T.T.A.B. 1967), stated "there is no question but that each of the words in a compound mark sought to be registered is a word which describes a feature of paper bound containers. . . . The mere fact that a compound mark is made up of descriptive words does not ipso facto create a mark which is merely descriptive when applied to an applicant's goods." Id.

Ultimately, the dissection of a mark into its component parts (as seen with SOUP SINGLES) stands against the clear weight of case law and the PTO's own rules of examination. See Coca-Cola Co. v. Seven-Up Co., 497 F.2d 1351 (C.C.P.A. 1974) ("We have said, so often as not to require citation of authority, that marks must be viewed as the public sees them, i.e. in their entirety"). To be sure, it is well-settled that the validity of a mark is not judged by an examination of its individual parts, but rather by viewing the trademark as a whole. See California Cooler, Inc., 774 F.2d at 1455. The rationale for the rule is that the commercial impression of a mark on a potential consumer is created by the mark in its entirety, not by its component parts. "It is axiomatic that a

mark should not be dissected and considered piecemeal"

Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 1007 (C.C.P.A. 1981). In other words, "[t]he whole, in trademark law, is often greater than the sum of its parts. Common words in which no one may acquire a trademark because they are descriptive or generic may, when used in combination, become a valid trademark." Association of Coop. Members, Inc. v. Farmland Industries, Inc., 684 F.2d 1134, 1140 (5th Cir. 1982), cert. denied, 460 U.S. 1038 (1983).

II. SOUP SINGLES™ IS A SUGGESTIVE COMPOSITE MARK

Applicant's mark SOUP SINGLES is the type of mark which the Farmland Industries court envisioned. Applicant is not attempting to register the terms "SOUP" or "SINGLES" as separate terms. Instead, Applicant is attempting to register its uniquely coined mark, SOUP SINGLES. In this context, the individual meanings of the terms "SOUP" and "SINGLES" are essentially melded, guiding the consumer's focus instead on to the meaning of SOUP SINGLES and its unique commercial impression.

When applying the Examining Attorney's evidence of record to the descriptiveness standard established through case law, Applicant's mark SOUP SINGLES surfaces as a composite mark that combines individual terms which, while arguably less protectible

individually, together function as one unique source identifier for Applicant's frozen soups. The mark lies on the suggestive side of the cusp that borders descriptiveness, so to speak. In other words, Applicant's mark is not a descriptor, but instead a "short, snappy way of suggesting advantageous characteristics of the goods." Minnesota Mining & Mfg. Co. v. Johnson & Johnson, 454 F.2d at 1180 (emphasis in the original).

Ultimately, where no evidence exists to show that Applicant's competitors "need" to use the mark SOUP SINGLES, and where SOUP SINGLES neither immediately conveys knowledge about a characteristic of the identified goods, nor is that purported characteristic significant from the relevant consumer's viewpoint, the mark must be found to fall short of descriptiveness and, accordingly, must be held registrable.

A. The Mark's Suggestive Qualities

Not only does Applicant's mark not immediately convey a quality, characteristic or function of Applicant's goods, but the commercial impression given by Applicant's mark in context is far different than as argued by the Examining Attorney. When viewed as a whole, and when considering its sound and cadence, the mark is highly suggestive.

At the outset, it is clear to the consumer that the pronunciation and sound of SOUP SINGLES is characterized by the alliteration of the first letter, "S," of both component terms

in the mark, and a sharp cadence formed between the words "SOUP" and "SINGLES" that results from the emphasis on both words being placed on the beginning of the word. As such, the mark forms a suggestive whole by the distinctive sound and cadence spoken by any consumer. See T.M.E.P. § 1213.05(e).

At worst, Applicant need only disclaim "SOUP." However, when viewing Applicant's mark as a whole, the allegedly merely descriptive meaning is not apparent or immediate. Instead, the suggestive commercial impression of SOUP SINGLES far outweighs any descriptive meaning. As such, Applicant's mark must be passed on to publication.

B. Lack of Probative Descriptiveness Evidence

There is no persuasive evidence that Applicant's use of "SINGLES" as part of its composite mark will immediately convey to the typical consumer any particular significant characteristic of Applicant's frozen soups.

Beyond dictionary definitions, the Examining Attorney cites web pages on which products are available for sale where the word "singles" appears in proximity to the name of a food product. As a whole, such evidence is unpersuasive. The mere existence of "singles" in connection with other food products on a webpage does not support the Examining Attorney's descriptiveness argument. Moreover, there is no evidence of

record as to consumer perception of the word "single" used in connection with food.

In the practicalities of the market-place, when juxtaposed, the components of Applicant's mark provide anything but a well-understood or recognized meaning as applied to Applicant's frozen soups. SOUP SINGLES is a clever alliterative product name, which suggests the portion size, but also cleverly suggests the consumers who would find the product convenient -- individuals living alone or perhaps seeking a one course meal. Applicant's creative mark is suggestive since SOUP SINGLES does not immediately convey any one message. The Examining Attorney downplays the mark's suggestiveness and overlooks the crucial fact that the one attribute of the goods identified by the mark must be a significant attribute and that the connection between the mark and the goods must be immediate and readily understood. See In re Bright-Crest, Ltd., 204 U.S.P.Q. 591 (T.T.A.B. 1979); and In re H.U.D.D.L.E., 216 U.S.P.Q. 358 (T.T.A.B. 1982). After separating the tenable evidence from the untenable, nothing remains to diminish the unique cadence and suggestive function of Applicant's mark. A mark merely with *meaning* in relation to the identified goods, without more, does not equate with descriptiveness under § 2(e)(1).

**III. IN THE ALTERNATIVE, APPLICANT HAS ESTABLISHED ACQUIRED
DISTINCTIVENESS THROUGH ACTUAL EVIDENCE.**

The Lanham Act provides, in pertinent part, that "nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce." 15 U.S.C. § 1052(f). It is pursuant to this section of the Lanham Act that Applicant's mark SOUP SINGLES deserves registration.²

Acquired distinctiveness is generally understood to be an association in the minds of consumers between a given mark and the source of the goods or services. Applicant has submitted ample evidence that SOUP SINGLES has acquired distinctiveness in the marketplace. The T.M.E.P. sets forth a variety of ways to demonstrate that a mark has acquired distinctiveness. An applicant can: (1) demonstrate continuous and exclusive use for at least five years; (2) demonstrate through submission of actual evidence that its mark has acquired distinctiveness; or (3) rely on one or more prior registrations on the Principal Register of the same mark covering goods similar to those named in the pending application. T.M.E.P. § 1212.04 - 1212.06. The record in this case clearly reflects that Applicant has satisfied the second test for acquired distinctiveness.

² For purposes of clarification, Applicant is not willing to accept registration on the basis of acquired distinctiveness unless and until the Board determines that SOUP SINGLES is not entitled to a registration on the Principal Register without such a showing. See T.B.M.P. § 1215.

Pursuant to Rule 2.41(a), an Examining Attorney may accept as evidence of acquired distinctiveness, declarations, advertising expenditure figures, or other appropriate evidence showing the duration, extent, and nature of use in commerce of a proposed mark. 37 C.F.R. § 2.41(a); T.M.E.P. § 1212.06.

In the case, In re Owens-Corning Fiberglas Corp., 774 F.2d 1116 (Fed. Cir. 1985), the Board explained the type of evidence required to support a claim of acquired distinctiveness:

An evidentiary showing of secondary meaning, adequate to show that a mark has acquired distinctiveness indicating the origin of the goods, includes evidence of the trademark owner's method of using the mark, supplemented by evidence of effectiveness of such use to cause the purchasing public to identify the mark with the source of the product.

Id. at 1125; T.M.E.P. § 1212.06. This presents no problem for Applicant here.

In Applicant's Request for Reconsideration dated September 22, 2011, Applicant first submitted evidence in support of its claim that SOUP SINGLES has acquired distinctiveness by virtue of Applicant's extensive marketing, advertising and promotion of the mark in commerce, as further reflected by the response from, and recognition of source by, the consuming public and the media. Applicant presented actual evidence of acquired distinctiveness as described in a Declaration of Benjamin Tabatchnick, Applicant's President. Specifically, Applicant showed evidence of sales at numerous retailers in at least

fifteen states, Internet promotion of Applicant's mark, expenditures of substantial sums of money on advertising and promoting the goods under the SOUP SINGLES mark, and online coverage and testimonials by third parties.

In Applicant's April 18, 2012 Response to Office Action, Applicant provided further evidence of sales under the mark, samples of advertising, and marketing statistics. Applicant included an additional Declaration of Benjamin Tabatchnick, Applicant's President, in which the following facts were set out:

1. Applicant's gross revenues from its SOUP SINGLES frozen soups were \$315,466.50 for the six-month period from July to December 2011. The gross revenues have substantially increased during each of the preceding six-month periods.
2. Applicant currently sells its SOUP SINGLES frozen soups through many famous stores, including Pathmark, ShopRite, DeMoulas, Big Y, A&P, Weiss Markets, Walbaums, King Kullen, and CVS. Applicant will be selling its SOUP SINGLES frozen soups at Stop & Shop, Safeway, Krogers, Publix, and Winn Dixie in summer 2012.

4. Applicant has advertised its trademark SOUP SINGLES on its website, which is located at <www.tabatchnick.com>.
5. Additionally, Applicant has advertised its trademark SOUP SINGLES on its Facebook® page, located at <https://www.facebook.com/tabatchnick>, since November 11, 2010.
6. Applicant has engaged in extensive advertising and marketing efforts, including trade shows (e.g., Kosher Food Expo, Shoprite Food Expo), circulars, public-relations pieces in newspapers and magazines, and blogs.
7. Lastly, Applicant states that the mark has become distinctive of the goods through the Applicant's substantially exclusive and continuous use in commerce since July 2010.

Applicant's establishment of SOUP SINGLES throughout the food industry, combined with Applicant's evidence of marketing, promotion, and advertising, is irrefutable support for acquired distinctiveness here.

Section 1212.06(b) of the T.M.E.P. states that "[l]arge scale expenditures in promoting and advertising goods and services under a particular mark are significant to indicate the extent to which a mark has been used." The examination of such

evidence centers on the method of use, commercial impression, and meaning of such use to prospective purchasers. Accordingly, in support of its Section 2(f) claim, Applicant noted its extensive advertising and marketing efforts, including trade shows (e.g., Kosher Food Expo, Shoprite Food Expo), circulars, public-relations pieces in newspapers and magazines, and blogs.

Section 1212.06(c) of the T.M.E.P. establishes that declarations asserting recognition of the mark as a source indicator are relevant in establishing a Section 2(f) claim of acquired distinctiveness. Accordingly, in Applicant's Request for Reconsideration dated September 22, 2011, Applicant entered into the record as Exhibit A the Declaration of Benjamin I. Tabatchnick, Applicant's President. The content of the Declaration articulates the extensive advertising, marketing and promotion of the SOUP SINGLES mark.

Ultimately, Applicant has successfully satisfied the requirements of Rule 2.41, the T.M.E.P., and the Board, by providing extensive, varied, and detailed evidence of consumer and industry perception of the mark SOUP SINGLES. Whether through evidence of Applicant's advertising and promotion expenditures, or through Applicant's detailed Declarations and the facts supplied therein, Applicant respectfully submits that it has backed up its claim of acquired distinctiveness and

demonstrated that it is deserving of registration pursuant to Section 2(f).

IV. ALL DOUBTS CONCERNING REGISTRATION SHOULD BE RESOLVED IN APPLICANT'S FAVOR

The two principal concerns of trademark law, both of which promote competition, are: (i) protect consumers against confusion and monopoly; and (ii) protect the investment of producers in their trade names in which goodwill may have accrued. Union Nat'l Bank of Texas, Laredo, 909 F.2d at 843-44; see also Park 'N Fly, Inc. v. Dollar Park 'N Fly, Inc., 469 U.S. 189, 198 (1985) ("[T]rademarks foster competition and the maintenance of quality by securing to the producer the benefits of the good reputation.")

Under such circumstances, the PTO should have a strong preference for allowing for full registration of a mark where "[d]enial of registration does not deny the owner the right to use the mark, and thus will not serve to protect the public from confusion." In re Four Season Hotel, Ltd., 987 F.2d 1565, 1566 (Fed. Cir. 1993). While Four Season Hotel concerned the weight of consent agreements, an aspect not at issue here, the principle espoused by the Federal Circuit in that case resonates here nonetheless. Thus, the Trademark Office's rule is to

protect the owner of trademarks by allowing them to register their marks, not to make them disclaim matter. Id.

The Court of Customs and Patent Appeals long cautioned against the overzealous policy of the Trademark Examining Operation, as evidenced in the case In re Nat'l Distillers & Chem. Corp., observing:

[I]n speaking of the law enacted to protect trademark owners, there is considerable risk of error in pursuing a policy under which the administrative agency deems itself to be guarding the public interest whenever it refuses to register. It properly guards those interests only when such refusal truly furthers those interests. They are not furthered by denying registration to an established, widely used trademark.

In re Nat'l Distillers & Chem. Corp., 297 F.2d 941, 953 (C.C.P.A. 1962) (Rich, J., concurring). While In re National Distillers involved issues of confusion and consent, it nevertheless reflects that the clear weight of authority is to resolve the doubt in the applicant's favor and to publish the mark for opposition. After all, "any person who believes that he would be damaged by the registration will have an opportunity . . . to oppose the registration of the mark and to present evidence," In re Gourmet Bakers, Inc., 173 U.S.P.Q. 565, 565 (T.T.A.B. 1972).

As the Federal Circuit stated in the case, In re Merrill Lynch, Pierce, Fenner, & Smith, Inc., 828 F.2d 1567, 1571 (Fed.

Cir. 1987), "[i]t is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark, and to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent." In its reasoning, the Court relied upon the case, In re Application of Aid Labs., Inc., 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1983), which held the mark PEST PRUF to be suggestive of a possible end result of use of identified goods, and not merely descriptive, for animal shampoo with insecticide, thereby resolving doubt in favor of the applicant. "Where there is doubt on the matter, the doubt should be resolved in applicant's behalf and the mark should be published in accordance with Section 12(c) of the [Lanham] Statute for purposes of opposition." Id.; see also In re The Gracious Lady Service, Inc., 175 U.S.P.Q. 380, 382 (T.T.A.B. 1972) ("It is recognized that there is a large gray area in determining the descriptiveness of a mark, and where reasonable men may differ, it has been the practice to resolve such doubt in an applicant's behalf and publish the mark for opposition purposes"); and In re Entenmann's Inc., 15 U.S.P.Q.2d 1750, 1751 n.2 (affirming decision under Section 2(e)(1) but recognizing "that in ex parte cases involving a refusal to register on the basis of mere descriptiveness, it is the

practice of this Board to resolve doubts in the favor of the applicant and pass the mark to publication").

In the case, In re Pennwalt Corp., 173 U.S.P.Q. 317 (T.T.A.B. 1972), the Board held that, "although it is highly suggestive of applicants goods, [DRI-FOOT] possess redeeming features which raise doubts as to the application of the 'merely descriptive' appellation." Pennwalt, 173 U.S.P.Q. at 318. Further the Board stated that "doubt should be resolved in applicant's favor and the mark should be published in accordance with Section 12(a) for opposition purposes thereby enabling any person who believes that he would be damaged by the registration of said mark to present evidence to that effect not present herein." Id.

By passing the mark to publication, the market, not the Examining Attorney, will be the true arbiter of the mark.

CONCLUSION

For the foregoing reasons, Applicant, Somerset Soup Works, Inc., respectfully requests that the Trademark Trial and Appeal Board reverse the Examining Attorney's final refusal to register its trademark, allowing for publication for opposition.

Respectfully submitted,

SOMERSET SOUP WORKS, INC.

Dated: July 24, 2012

By: /Matthew A. Homyk/
Timothy D. Pecsénye
Megan E. Spitz
Matthew A. Homyk
BLANK ROME LLP
One Logan Square
Philadelphia, PA 19103
(215) 569-5619